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In re Application of COSTA et al :
U.S. Application No.: 10/522,039 :
PCT Application No.: PCT/US2003/019993 :
Int. Filing Date: 24 June 2003 :
Priority Date Claimed: 19 July 2002 : DECISION
Attorney Docket No.: 25791.106.02 :
For: PROTECTIVE SLEEVE FOR THREADED :
CONNECTIONS FOR EXPANDABLE :
LINER HANGER :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 27 August 2007.

BACKGROUND

On 24 June 2003, applicant filed international application PCT/US2003/019993, which claimed priority of an earlier United States application filed 19 July 2002. The thirty-month period for paying the basic national fee in the United States expired on 19 January 2005.

On 19 January 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification.

On 18 April 2006, applicant's deposit account was debited for excess claim fees.

On 27 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of international application PCT/US2003/019993 reveals that the application contained 253 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, although applicant may have sought to reduce the number of claims for examination at the time of national stage entry, the initial national stage submission on 19 January 2005 did not include a proper preliminary amendment. Therefore, the properly formatted yet subsequently filed amendment of 27 August 2007 does not entitle applicant to a refund of the previously paid excess claim fees. The petition fails to make a sufficient showing that a miscarriage of justice would occur if the Office adheres to the requirement plainly set forth in MPEP 1893.01(c) and noted above.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Lin

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